

### **REMARKS**

Claims 2-21 are in the application.

The claims have been amended to more clearly point out and distinctly claim applicants' invention. Independent claim 1 has been cancelled and new independent claim 19 has been introduced. The dependency of the dependent claims has been changed so that the dependent claims now depend from the new independent claim 19 rather than cancelled claim 1. New independent claim 21 includes the subject matter of cancelled claim 1 and dependent claims 2, 3, 4, 5 and 7, presented in the form of a Markush group. Claim 13 has been amended to correct an inadvertent inconsistency, with a portion of the subject matter being presented in new claim 20. A few minor spelling errors have also been corrected. The amendments to the claims are fully supported by the disclosure, and no new matter is introduced thereby.

Applicant gratefully notes that claims 2-5 and 7 stand objected to as being dependent on a rejected base claim, but would be allowable if rewritten in independent form including all limitations of the base claims and any intervening claim. Applicant has rewritten these claims as a single new independent claim 21, incorporating the limitations of dependent claims 2-5 and 7 as a Markush group rather than presenting five new independent claims. Allowance of claim 21 is respectfully requested for this reason.

Claims 15 and 16 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. This rejection is respectfully traversed and reconsideration and withdrawal of the rejection as applicable to the amended claims are respectfully requested.

The Examiner states that the claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which

it pertains, or with which it is most nearly connected, to make and/or use the invention. In particular, the Examiner states that with respect to claim 15, the specification fails to disclose what the term "chasing" means, and that with respect claim 16, the specification also fails to disclose what the phrase "partitioned enamel technique" means.

These expressions are terms of art in the relevant arts, and well understood by one of ordinary skill in the metalworking and/or decorative arts. The techniques themselves have been known and used since antiquity. The "partitioned enamel technique" is more commonly known in English by the French term "cloisonné," which according to the dictionary is enamel work in which the colored areas are separated by thin metal bands. "Chasing" refers to ornamenting metal by engraving or embossing, according to the dictionary definition. Applicants enclose dictionary excerpts providing the cited definitions, and requested reconsideration and withdrawal of this rejection because the terms are well-known in the art, such that no explanation need be provided in the specification to enable the practice of the invention so claimed.

Claim 13 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

This rejection is respectfully traversed, and reconsideration and withdrawal of the rejection are respectfully requested as applicable to the amended claims.

The Examiner notes that a broad range or limitation together with a narrow range or limitation that falls within the broad range in the same claim is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired, citing MPEP ¶ 2173.05(c), Ex parte Wu, 10 USPQ2d

2031, 2033 (BPAI 1989), et al. In particular, the Examiner notes that in the present instance, claim 13 recites the broad recitation "shaped surface" and the claim also recites "corrugated surface," a narrower statement of the range or limitation.

In response to the Examiner's rejection, claim 13 has been amended to delete the recitation of a "corrugated surface." Reconsideration and withdrawal of this rejection in light of the amendment of this claim are respectfully requested.

Claims 1, 6, 8-10, 14, 17 and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 5,694,791 ("Esposito") in view of U.S. Patent 430,295 ("Mathewson").

This rejection is also respectfully traversed, and reconsideration and withdrawal of the rejection are respectfully requested as applicable to the amended claims.

The Examiner states that, regarding claims 1, 14 and 17, Esposito discloses a composite set of jewelry ornaments (referencing Figures 1 and 4a) containing decorative elements in the form of settings (10) and a connector with a lock (30). The Examiner notes that the decorative elements are composed of tubular (10) elements with settings (24) with stones (26). The Examiner further states that the decorative elements also have cross through openings (referencing the hole in the middle sections of the cylindrical element (10)). The Examiner admits that Esposito fails to disclose a combination of tubular elements and tubular elements with ornamentation.

The Examiner further states that Mathewson discloses the deficiency found in Esposito, and in particular, a bracelet with a plurality of beads (A, A') wherein a certain number of beads (A) contain an ornamentation (a) and the other beads (A') do not contain the additional ornamentation. The Examiner states that the combination of beads with

ornamentation and just plain beads is for aesthetic purposes only. The Examiner concludes that it would have been obvious to a person of ordinary skill in the art to provide Esposito with a combination of beads with ornaments and without ornaments in order to change and improve the aesthetic beauty of the jewelry item.

With respect to claims 6 and 8, the Examiner notes that Mathewson discloses dome-shaped beads (A, A').

With respect to claims 9 and 10, the Examiner notes that Esposito discloses tubular elements with a polished outer surface, which is inherently disclosed.

With respect to claim 18, the Examiner states that Esposito discloses a connector (30) in the form of a chain, that is, a link in a chain.

Applicant respectfully contends that the combination of Esposito and Mathewson does make out a *prima facie* case of obviousness of applicant's presently claimed invention.

First, Esposito does not disclose "tubular decorative elements" as that term is employed in the present disclosure and claims, but rather settings with through holes or eyeholes. Esposito expressly refers to these as "basket settings" throughout his disclosure and claims. Applicant's use of the term "settings" is entirely consistent with Esposito's use. In order to try to meet the limitations of applicant's claims, the Examiner incorrectly states that Esposito's "tubular elements" include "settings" referencing Esposito's reference numeral 24. However, Esposito instead refers to these elements as "prongs," the conventional, art-recognized name for the elements illustrated in Esposito's figures.

The Examiner identifies Esposito's basket settings 10 both as the decorative elements required by applicant's claims and as the tubular decorative elements required by applicant's claims. However, as disclosed and claimed by applicant, these must be different

elements, and the limitations of applicant's claims which require both simply cannot be met by Esposito, which discloses only one of these required elements.

Mathewson does not remedy this deficiency of disclosure. Mathewson discloses only "balls or shells" (lines 7-17) with rectangular perforations B (lines 40-46) and which must be substantially round in cross-section (lines 47-54) rather than decorative tubular elements.

Combining Esposito with Mathewson as suggested by the Examiner gives a jewelry set comprising basket settings and substantially round decorative elements, which does not meet the limitations of applicant's claims.

Since there is nothing in either reference to suggest or disclose the use of tubular decorative elements in a jewelry set to one of ordinary skill in the art, the combination of the cited references cannot render the presently claimed invention obvious.

Thus, applicants respectfully request reconsideration and withdrawal of the rejection entered under 35 U.S.C. § 103(a) over Esposito in view of Mathewson as applicable to the amended claims for these reasons.

Claims 11 and 12 stand rejected under 35 U.S.C. § 103(a) over Esposito in view of Mathewson, and further in view of U.S. Patent 263,095 ("Ballou").

This rejection is also respectfully traversed, and reconsideration and withdrawal of the rejection are respectfully requested as applicable to the amended claims.

The Examiner notes that Esposito fails to disclose using a matte finish on the tubular elements or a combination of a matte finish on some of the elements and a polished finish on the other elements. The Examiner states that Ballou discloses providing a variety of finishes (including "matte" finish, cross hatched finish) on alternating tubular elements of a decorative chain to vary and improve the aesthetic appearance of the chain. The Examiner concludes that it would have been obvious to one of ordinary skill in the art to provide Esposito with

alternating matte and polished finishes on the tubular elements in order to improve the beauty of the jewelry item.

Ballou discloses an ornamental chain comprising a plurality of short tubular wire elements A which are arranged side-by-side and alternately plain and ornamented. The tubular wire elements are connected by short loops of wire B that are passed through the tubular elements and the bent-over ends of the preceding wire loop. The ends are then bent over themselves, and the process is repeated to form the chain.

However, even if one of ordinary skill in the art were to apply the disclosure of Ballou to Esposito as suggested by the Examiner, she would not arrive at applicant's invention as claimed in claims 11 and 12. Ballou simply does not disclose a matte finish, but rather what would appear to be a surface embossed or engraved with cross-hatching. The surface itself could be polished, matte or anything in between. Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 11 and 12 over the combination of Esposito, Mathewson, and Ballou as applicable to the amended claims for this reason.

Applicant respectfully requests early reconsideration and allowance of all claims.